

REMARKS

Claims 1-23 are pending in the present application.

Claims 1-23 have been rejected.

Claims 1-23 remain in the present application. Reconsideration of the claims in view of the following arguments is respectfully requested.

In Section 2 of the May 20, 2004 Office Action, the Examiner rejected Claims 1-11, 14-20, 22 and 23 under U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 6,157,828 to *Krishnamurthi* (hereafter, "*Krishnamurthi*"). The Applicant respectfully traverses the rejection of Claims 1-11, 14-20, 22 and 23.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Applicants respectfully disagree with the rejection of Claims 1-24 and directs the Examiner's attention to Claim 1, which contains the unique and non-obvious limitations emphasized below:

1. (Original) For use in a wireless communications system, a mobile switching center comprising:

a controller which, in response to receiving a clear request triggered by a mobile station terminating call connections while a call involving the mobile station is holding following a call waiting notification to the mobile station, transmits a message to a base station serving the mobile station to maintain resource allocations designated for the mobile station and alert the mobile station of the holding call.

The Applicants respectfully assert that the above-emphasized limitations of Claim 1 are not disclosed, suggested, or even hinted at in the *Krishnamurthi* reference.

In rejecting independent Claims 1-11, 14-20, 22 and 23, the Examiner relied upon the text at column 4, line 64, through column 5, line 3, of the *Krishnamurthi* reference, which states:

Thereafter, [mobile station] MS 32 may toggle between party 1 28 and party 2 30 by pushing the key on the keypad to cause the generation of the Flash With Information Message. Each time [mobile switching center] MSC 36 receives the Flash With Information Message, it connects MS 32 to the party that was previously put on hold and puts on hold the party that was previously on the line.

The Applicants respectfully assert that the above-cited portions of the *Krishnamurthi* reference describe a mobile station toggling between two calling parties on hold, rather than terminating call connections, as recited in Claim 1.

The Examiner also relied upon the text at column 5, line 48, through column 6, line 4, of the *Krishnamurthi* reference, which states:

Referring to FIG. 3, assume again that party 1 28 is on hold and MS 32 is in communication with party 2 30. If party 2 30 then hangs up, the network servicing party 2 30 generates a Release Message as described above. In the preferred embodiment, when the Release Message comes from the network, MSC 36 intercepts it, and message generator 38 in MSC 36 generates an Alert With Information Message signal, which is sent to BS 34 on the A-Interface. Message receiver 40 in BS 34 receives the Alert With Information Message, and BS 34 in turn sends an Alert

With Information Message to MS 32 on the Air-Interface. When MS 32 receives the Alert With Information Message, it generates an alerting signal in the mobile and waits for the subscriber to answer. When the subscriber answers by pressing a key on keypad of MS 32, a Connect Message generated by MS 32 is sent to BS 34 and forwarded to MSC 36. On receiving the Connect Message, MSC 36 connects party 1 28 to MS 32.

In the preferred embodiment, by not permitting the Release Message (or a Clear Message) from the network to be sent to MS 32, MS 32 is not caused to release the traffic channel when party 2 30 hangs up. As a result, there is no need to expend additional Air-Interface resources for the assignment of a new traffic channel.
(emphasis added)

The Applicants respectfully draw the Examiner's attention to the emphasized portion of the passage and assert that the above-cited passage, and the *Krishnamurthi* reference as a whole, addresses unreliability and inefficient use of Air-Interface resources arising from A-Interface handling, as defined by the IS-634 standard, of the termination of the call connection by the landline party. *See Krishnamurthi col. 2, lines 18-20 and 36-43.* In contrast, the Applicants' invention addresses system-wide inefficiencies arising from the processing specified by IS-2001 when a mobile station user inadvertently presses the "End" button, rather than the "Talk" button, thereby terminating a call, rather than toggling to the party on hold. *See Application, page 2, line 1, through page 4, line 12.*

Therefore, independent Claim 1 contains unique and non-obvious limitations that are not disclosed, suggested, or even hinted at in the *Krishnamurthi* reference. This being the case, Claim 1 is patentable over the *Krishnamurthi* reference. Dependent Claims 2-4 depend from independent Claim 1 and contain all of the unique and non-obvious limitations recited in Claim 1. Thus, Claims 2-4 also are patentable over the *Krishnamurthi* reference.

Additionally, independent Claims 5, 9 and 18 contain limitations that are analogous to the unique and non-obvious limitations recited in Claim 1. This being the case, Claims 5, 9 and 18 are patentable over the *Krishnamurthi* reference. Finally, dependent Claims 6-8, 10, 11, 14-17, 19, 20, 22 and 23, which depend from independent Claims 1, 5, 9 and 18, contain all of the unique and non-obvious limitations recited in Claims 1, 5, 9 and 18. Thus, Claims 6-8, 10, 11, 14-17, 19, 20, 22 and 23 are patentable over the *Krishnamurthi* reference.

In Section 4 of the May 20, 2004 Office Action, the Examiner rejected Claim 12 under U.S.C. § 103(a) as being unpatentable over *Krishnamurthi* in view of U.S. Patent No. 5,884,196 to *Lekven et al.* (hereafter, "*Lekven*"). In Section 5 of the Office Action, the Examiner rejected Claim 13 under U.S.C. § 103(a) as being unpatentable over *Krishnamurthi* in view of U.S. Patent No. 6,108,563 to *Shishino* (hereafter, "*Shishino*"). In Section 6 of the Office Action, the Examiner rejected Claim 21 under U.S.C. § 103(a) as being unpatentable over *Krishnamurthi* in view of *Lekven* and further in view of *Shishino*. The Applicant respectfully traverses the rejection of Claims 12, 13 and 21.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is

established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

Claims 12 and 13 depend indirectly from independent Claim 1, and Claim 21 depends directly from independent Claim 18. Claims 12, 13 and 18 contain all of the unique and non-obvious limitations recited in their respective base claims. As described with regard to the § 102 rejection of independent Claims 1 and 18, the *Krishnamurthi* reference does not disclose, suggest, or even hint at

all the limitations of Claims 1 and 18. The Applicants respectfully assert that the *Lekven* and *Shishino* references do nothing to overcome the shortcomings of the *Krishnamurthi* reference with respect to the unique and non-obvious limitations in Claims 1 and 18. As such, the *Krishnamurthi*, *Lekven* and *Shishino* references, alone or in combination, fail to disclose, teach, or suggest the Applicants' invention as recited in Claims 12, 13 and 21. Thus, Claims 12, 13 and 21 are patentable over the cited prior art references.

SUMMARY

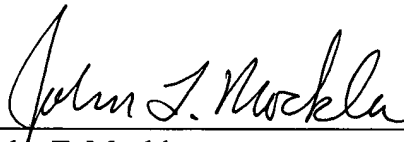
For the reasons given above, the Applicant respectfully requests reconsideration and allowance of pending claims and requests that this Application pass to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,
DAVIS MUNCK, P.C.

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P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@davismunck.com*



John T. Mockler
Registration No. 39,775